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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,999	12/18/2001	Daniel Hoo	659/792	3560

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EXAMINER
EDWARDS, LAURA ESTELLE

ART UNIT	PAPER NUMBER
1734	

DATE MAILED: 01/24/2003 4

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-4

Office Action Summary	Application No. 10/024,999	Applicant(s) HOO ET AL.	
	Examiner Laura E. Edwards	Art Unit 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) *1-17* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *18-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2, 3* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-17, drawn to a method, classified in class 427, subclass 356.

II. Claims 18-28, drawn to an apparatus, classified in class 118, subclass 227.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as applying adhesive or paint or other materials than wetting solutions.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with J. Taylor on 12/3/02 a provisional election was made without traverse to prosecute the invention of Group II, claims 18-28. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

Claims 18-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 18, Applicants refer to a hydrophobic web with a water dispersible binder and later in claim 26 refer to the web with a conventional add on so forth. Therefore, it is unclear whether Applicants intend for the web to be a part of the claimed invention as a combination. Presently, the web is merely read as the substrate intended to be used with the apparatus. In order for the web to be given patentable weight, a source or supply of the web must be recited in the body of claim 18. Clarification is necessary.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18, 22, 26, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Leonard et al (US 3,844,813).

Leonard et al teach an apparatus for wetting a web substrate comprising a pair of press or nip rolls (31, 32; see col. 5, lines 35-41) and a solution applicator (34) which delivers wetting solution (see col. 9, lines 24-30 and lines 56-58) to a web wherein the web passing between the rolls effects a web with an add-on in moisture weight of at least 25% (see col. 11, lines 19-23). Leonard et al further recognizes the use of the apparatus with a variety of substrates including water repellant type materials (see col. 8, lines 60+ to col. 9, lines 14). Presently, Applicants' web material, which is intended to be used with the apparatus, has been given no patentable weight.

With respect to claim 26, this claim has been given no patentable weight as it appears to be a limitation to the type of web material used and not a structural limitation to the apparatus.

With respect to claim 28, the trough (34) delivers wetting solution directly to the nip rolls.

Claims 18-22 and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Bolton et al (US 4,447,924).

Bolton et al teach an apparatus for wetting or moistening a web substrate with a desired chemical comprising a pair of press or pull rolls (64, 65) and a solution applicator (26) which delivers a chemical solution to a web wherein the web passing between the rolls effects a web with an add-on in moisture weight of at least 25% (see col. 6, lines 17+). Bolton et al recognizes

the use of the apparatus with a variety of fabric blends (see col. 6, lines 17-21). Presently, the web material has been given no patentable weight.

With respect to claims 19-21, Bolton et al show a spray boom or drool bar or fluid distribution header (26, 28).

With respect to claim 25, see rolls (76, 78).

With respect to claim 26, this claim has been given no patentable weight as it appears to be a limitation to the type of web material used and not a structural limitation to the apparatus.

Claims 18, 21, 22, and 26-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Bafford et al (US 5,089,296).

Bafford et al teach an apparatus for wetting a web substrate comprising a pair of press or nip rolls (7, 8) and a foam applicator (5, 6) which delivers foam including a wetting solution (see EXAMPLE 1) to a web wherein the web passing between the rolls effects a web with a wet % add-on of at least 25% (see col. 8, Table 1). Bafford et al recognize the use of the apparatus with a variety of substrates including kraft paper as well as woven and non-woven fabrics (see col. 1, lines 10-12). Presently, the web material has been given no patentable weight.

With respect to claim 21, see col. 4, lines 65+.

With respect to claim 22, see col. 7, lines 38-43.

With respect to claim 26, this claim has been given no patentable weight as it appears to be a limitation to the type of web material used and not a structural limitation to the apparatus.

With respect to claims 27 and 28, it appears that the foam is applied to the web as well as to the nip rolls.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leonard et al (US 3,844,813).

The teachings of Leonard et al have been mentioned above but Leonard et al are silent concerning the distance that the nip rolls are separated. However, Leonard et al recognize setting the gap so as to provide a continuously flooded nip (see col. 18, lines 40-45) such that it would have been obvious to one of ordinary skill in the art to appropriately set the gap between the rolls so as to maintain the flooded nip and the distance would be determined via routine experimentation.

Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolton et al (US 4,447,924).

The teachings of Bolton et al have been mentioned above but Bolton et al are silent concerning the distance that the nip rolls are separated. However, because the rolls (64, 66) are designed to pull and remove the web from the first wetting without removing an excess of moisture, it would have been obvious to one of ordinary skill in the art to appropriately set the gap between the rolls so as to maintain conveyance and tension of the web yet not remove an excess amount of moisture from the web. The exact distancing between the two rolls would be determined via routine experimentation.

With respect to claim 24, even though Bolton et al are silent concerning characteristics of the nip rolls (64, 66) including a covering of desired hardness, one of ordinary skill in the art would it have found it obvious to provide a covering of desired characteristics so as to tension and pull the treated web yet not remove an excessive amount of moisture from the treated web.

Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bafford et al (US 5,089,296).

The teachings of Bafford et al have been mentioned above but Bafford et al are silent concerning the distance that the nip rolls are separated. However, Bafford et al recognize that the padder rolls (7, 8) are adjusted [distanced] to meter a desired amount of foam onto the web (see col. 7, lines 38-43) such that it would have been obvious to one of ordinary skill in the art to appropriately set the gap between the rolls so as to meter a desired amount of foam onto the web. The exact distancing between the two rolls would be determined via routine experimentation.

With respect to claim 24, even though Bafford et al are silent concerning characteristics of the padder rolls (7, 8) including a covering of desired hardness, one of ordinary skill in the art

would it have found it obvious to provide a covering of desired characteristics so as to pad and meter the web as it passes between the two rolls.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patent recognizes kraft paper as being water and moisture resistant because of its high concentration of binders and fillers (see col. 2, lines 41-48): Intili (US 4,533,435).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura E. Edwards whose telephone number is (703) 308-4252. The examiner can normally be reached on M-Th/First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (703) 308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7115 for regular communications and Same as above for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Laura E. Edwards
Primary Examiner
Art Unit 1734

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January 15, 2003